

OLIVER NICKEL
USSN 09/844,083REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicant respectfully requests that the Examiner reconsider and withdraw the finality of the Office Action. Claim 1 is rejected for the first time under 35 USC §112. Such rejection was not necessitated by Applicant's prior amendment did not necessitate the new ground of rejection since Applicant's previous amendment did not even amend claim 1. Therefore, the new ground of rejection could have been made in the previous Office Action, but was not. Such new ground of rejection not necessitated by Applicant's previous amendment precludes the outstanding Office Action being final.

The Examiner requested that the first paragraph of the specification be amended to include a cross-reference to copending U.S. Serial No. 09/431,849. Although the two applications are "related" in the sense that they claim similar subject matter, the instant application has not claimed priority of U.S. Serial No. 09/431,894. Therefore, no reference is necessary to the copending application in the instant application.

Claim 1 was rejected under 35 USC §112. In response, Applicant submits that claim 1 on page 6 of the original application does, in fact, specify the claim number.

Claims 1-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-9, 11 and 12 of

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U.S. Serial No. 09/431,849. In response, Applicant submits a terminal disclaimer relative to the copending application.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
NORRIS McLAUGHLIN & MARCUS, P.A.

By _____
Kurt G. Briscoe
Reg. No. 33,141

220 East 42nd Street - 30th Floor
New York, New York 10017
Tel.: (212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116, Petition for Extension of Time, and Terminal Disclaimer (9 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: January 27, 2003

By _____
Kurt G. Briscoe

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January 27, 2003

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USSN 09/844,083**MARK-UP SHOWING THE CHANGES MADE IN THE PREVIOUS CLAIM TO
YIELD THE CLAIM AS AMENDED ABOVE**

- 1. (Once Amended) A masking tape comprising:
- a) a heat resistant adhesive tape [(1)] with] comprising a flexible sheet backing [(2)] and a pressure-sensitive adhesive composition[(3)],
 - b) a masking material[(5)], which is laminated in [the] an edge region [(4)] of the pressure-sensitive adhesive composition[(3)], [has good adhesion to paint and a good absorptive capacity, as well as] said masking material being capable of adhering to paint and of absorbing paint, and
 - c) a masking sheet[(6)], which is laminated onto [the very same] said edge region [(4)] of the pressure-sensitive adhesive composition[(3)],
 - [d)] the masking sheet [(6) completely] covering the masking paper (5) at the] material on a side thereof, [, where the pressure-sensitive adhesive composition (3) of the adhesive tape (1) is, and, with that, backing the masking paper (5) in the glued-on state.]~